

Application No. 10/022,668
Docket No. 2001U013.US
Reply to Office Action Dated November 24, 2004

Remarks

Section 102 Rejections

The rejection of Claims 1-9 and 11-17 under 35 U.S.C. § 102(b) as being anticipated by *Imuta et al* (EP 0 893 454 A1) was maintained. The Applicant traverses.

Claim 1 is amended by further defining "R" by adding the phrase –provided that when R is a branched chain alkyl group, the branch point is at least 3 atoms removed from X–. This limitation derives from the specification as filed at, for example, page 10 paragraph [0014]. No new matter is believed to be added.

Claim 1 is also amended by further defining "M" by replacing the phrase "a metallic element selected from Groups 3 to 7 atoms and the Lanthanide series of the Periodic Table of the Elements" with –zirconium–. This limitation is a selection from the original Markush group, and supported by the working examples and other aspects of the specification as filed. No new matter is believed to be added.

In maintaining the rejection, the Examiner cites *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), stating that in that case, "claims to a specific compound were anticipated because the prior art taught a generic formula embracing a limited number of compounds closely related to each other in structure and the properties possessed by the compound class of the prior art that was disclosed for the claimed compound." (emphasis added). The Applicant agrees, and for that reason, maintains that, as currently amended, *Imuta* does not anticipate the claimed embodiment of Applicant's invention.

The court in *Schaumann* made clear that there was no per se rule regarding anticipation under Section 102 when a specie or subgenus is being claimed and the prior art discloses a large genus. *Id.* at 316 (comparing the holding in *Petering* to the current case, the situation being fact intensive). In *Schaumann*, as the Examiner here has recognized, the claims at issue were held anticipated by the prior art because the prior art

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disclosed "a generic formula embracing a limited number of compounds closely related to each other" *under which the claimed specie fell*.

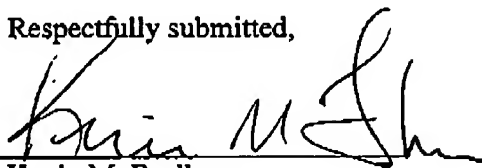
The key distinction presently is that *Imuta* does not disclose a limited number of compounds under which Applicant's claimed specie would fall. *Imuta* does not particularly disclose an unsymmetrical zirconium compound as is currently claimed, "unsymmetrical" meaning that the R and R' groups are distinct from one another. All of the compounds particularly disclosed as preferred embodiments in *Imuta* are symmetric titanium, palladium or nickel compounds. Thus, Applicant's claimed invention falls outside even the disclosure of the "limited number" of preferred compounds of *Imuta*.

Applicant thus requests that the Examiner reconsider the rejection over *Imuta* in light of the currently amended claims and the holding in *Schaumann*.

The Applicant invites the Examiner to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Examiner's satisfaction.

12/6/04
Date

Respectfully submitted,


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